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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/072,994	05/05/1998	GUILLAUME COTTAREL	GPCI-P02-032	7183

7590 02/21/2002

DOCKETING SPECIALISTS 33/48
ROPES & GRAY
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/072,994

Applicant(s)

Cottarel et al.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 10, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Nov 9, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The newly submitted claim amendment raise the issue of further consideration and search because of the amendment to the term "identical" and the change in the specific conditions of hybridization.

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: none
Claim(s) objected to: none
Claim(s) rejected: 14-22 and 37-40
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

Michael D. Pak
MICHAEL PAK
PRIMARY EXAMINER

Attachment to Advisory

1. The Advisory Action, subsection #6, regarding request for reconsideration of rejection.

The reason for the rejection has been set forth previously and the newly amended claims have not been entered.

2. Claims 14-22 and 37-40 remains rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

The reasons for the rejection has been set forth in the previous office action.

Applicants argue that the law makes no such distinction regarding the consideration of references published after the priority date of the application. Applicants argue that MPEP 2107.03 permits filing of data to rebut a rejection under 35 USC 101. However, it should be noted that MPEP 2107.03 is discussing therapeutic or pharmaceutical utility which is different from the current rejection. Furthermore, the submission of data was in the form of the Declaration discussing the submitted evidence. Applicants further argue that *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995) reversed the examiner based on a declaration provided during the prosecution. Again, *In re Brana* deals with therapeutic or pharmaceutical utility which is

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the specification on page 25 does state the assertion of the utility of CAK1 for diagnosis of yeast infection. However, the assertion is not a specific and substantial utility but rather is a general utility which is applicable with any Candida nucleic acid. CAK1 is an orphan kinase whose substrate activity or function is not known. The closest structural identities with prior art are to many different kinases at approximately 25% sequence identity. Applicants have not indicated how the specific CAK1 disclosed in the specification leads to the specific diagnosis asserted.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Michael D. Pak

Michael Pak
Primary Patent Examiner
Art Unit 1646
12 February 2002



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Total number of pages: 21

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